

REMARKS

Amendments to the Claims

Claims 1, 15 and 54 have been amended by selecting the value of variable V to be CH by deleting variable V from the claim text and from Structural Formula I. No new matter is added by this amendment.

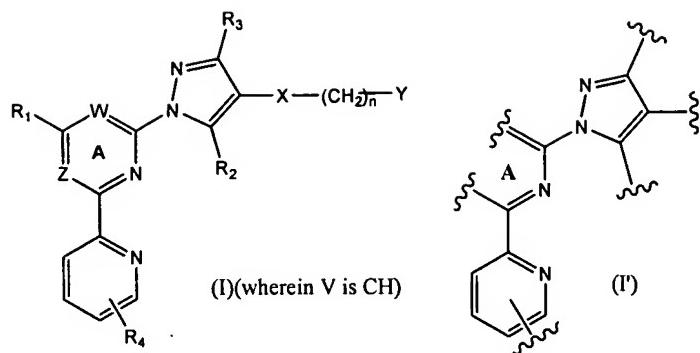
The Restriction Requirement is Traversed

A restriction between Groups I, II, and IV improperly restricts the claimed subject matter among a Markush group. When compounds included within a Markush group have a common structural feature essential to a common utility, restriction among the compounds of the group is improper. The M.P.E.P., § 803.02 states:

...it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. In re Harnish, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and Ex parte Hozumi, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature disclosed as being essential to that utility.

Each compound in Groups I, II, and IV shares (1) the common utility of being a modulator of TNF- α signaling.

Further, each compound in Groups I, II, and IV shares (2) a substantial structural feature disclosed by the application as being essential to that utility. In Groups I, II, and IV, the substantial structural feature is fragment (I'), contained in amended Structural Formula (I):



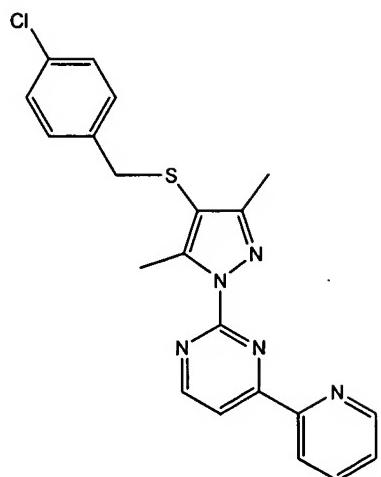
Thus, each compound in Groups I, II, and IV has a substituted pyrazolyl ring and a substituted pyridine ring coupled *meta* to each other across the depicted nitrogen of six-membered heteroaryl Ring A. Therefore, the compounds of Groups I, II, and IV share the substantial structural feature (I'), and restriction between them is improper. Withdrawal of the restriction requirement between Groups I, II, and IV is respectfully requested.

If the Examiner believes that there is any difficulty in searching Groups I, II, and IV in combination, it is requested that the restriction requirement be withdrawn and replaced with a requirement for election of species. The M.P.E.P., § 803.02 provides the procedure for examining Markush-type claims:

As an example, in the case of an application with a Markush-type claim drawn to the compound C-R, wherein R is a radical selected from the group consisting of A, B, C, D, and E, the examiner may require a provisional election of a single species, CA, CB, CC, CD, or CE. The Markush-type claim would then be examined fully with respect to the elected species [. . .] On the other hand, should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended. If prior art is then found that anticipates or renders obvious the Markush-type claim with respect to a non-elected species, the Markush-type claim shall be rejected and claims to the nonelected species held withdrawn from further consideration. The prior art search, however, will not be extended unnecessarily to cover all nonelected species.

Thus, the proper U.S.P.T.O. procedure is for the Examiner to issue a requirement for election of species, and to examine the Markush-type claim using Applicants' elected species. Upon finding no prior art that anticipates or renders obvious the elected species, the search should be extended to unelected species until the Examiner is convinced that the Markush-type claim is patentable.

Should the Examiner require an election of species, Applicants hereby elect as the species the compound from Claim 6, reproduced below:



Claims readable on the elected species are 1-3, 5, 6, 15-17, 19-32, and 53.

Thus, the restriction requirement between Groups I, II, and IV is improper because each compound in the claims, as amended, shares (1) the common utility of being a modulator of TNF- α signaling and (2) the substantial structural feature (I') disclosed by the application as being essential to that utility. Therefore, the Examiner is respectfully requested to replace the restriction requirement with a requirement for election of species, and to examine the application on the merits using Applicants' elected species.

When the restriction requirement is modified as detailed above, the claims elected for prosecution include Claims 1-59 as amended.

Further, Applicants note that the amendment to select V as CH, the search burden is reduced to Groups I, II, and IV. As noted above, these groups share the substantial structural feature (I') and in fact, only differ from each other by one or two nitrogen atoms in six membered heteroaryl Ring A. M.P.E.P., § 803.02 states

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Because the search burden has been reduced, and the remaining Groups share a substantial structural feature, there is no burden on the Examiner to examine Groups I, II, and IV on the merits.

CONCLUSION

In view of the above remarks, it is believed that the subject matter of Groups I, II, and IV can be searched without restriction, and it is respectfully requested that the application be examined on the merits. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned.

Respectfully submitted,

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